

REMARKS

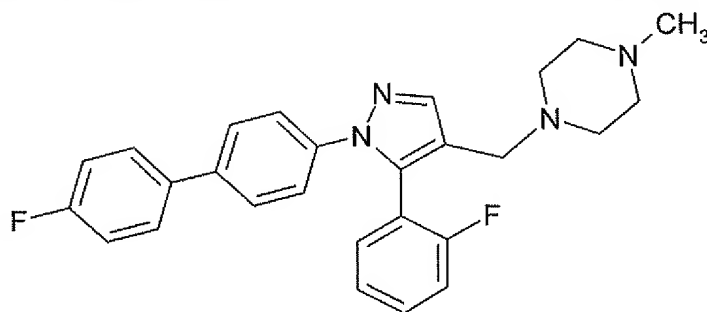
Status of Claims / Election

The Office Action indicates that the examination has been on compounds where the substituents are as defined on page 2 of the Office Action.

The Office Action also identifies the elected species as 1-[1-(4'-Fluoro-biphenyl-4-yl)-5-(2-fluoro-phenyl)-1H-pyrazol-4-ylmethyl]-4-methyl-piperazine.

However, there appears to be an error, since the compounds of formula I indicated to be examined do not contain the elected species.

To illustrate the above, the structure of the elected species is reproduced below (which structure was also provided in the Reply to the restriction requirement).



In the compounds of formula I identified to have been examined, R^1 is identified as H. However, the elected species has R^1 as **phenyl that is substituted in the para-position by F**.

In the compounds of formula I identified to have been examined, R^3 is identified as H. However, the elected species has R^3 as **$(CH_2)_n$ Het, (in which n is 1 and Het is 4-methyl-piperazine).**

In the compounds of formula I identified to have been examined, R^4 is identified as $(CH_2)_2N(R^5)_2$, wherein n is 4, R^5 is A and A is methyl. However, the elected species has R^4 as **H**.

Clarification of the examined matter is respectfully requested.

The Rejection Under 35 USC § 103

Applicants respectfully submit that the rejection is erroneous.

Applicants respectfully disagree with the allegations. Nevertheless, the claims are amended to advance this application to an expeditious allowance.

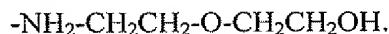
The Office Action alleges that it would have been obvious to take the species

allegedly close to the compounds of the present application and change therein a CH₂ group to oxygen because the general formula allows for such a group to be present in the Y group in which a CH₂ would have to be replaced with an O group.

Applicants respectfully disagree with this allegation. As the Examiner well knows, it is impermissible in patent law to take various parts of a species and combine it with various other parts of other species or with other parts of a general formula. See, for example, *In re Jones*, 958 F.2d 347, 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992) and *In re Baird*, 16 F.2d 380, 29 U.S.P.Q. 2d 1550 (Fed. Cir. 1994).

See also a recent decision of the Federal Circuit on this issue cautioning “that generalization should be avoided insofar as specific chemical structures are alleged to be prima facie obvious one from the other,” and that “in addition to structural similarity between the compounds, a prima facie case of obviousness also requires a showing of ‘adequate support in the prior art’ for the change in structure.” See *Takeda Chemical Industries Ltd. v. Alphapharm Pty. Ltd.*, 83 USPQ2d 1169 (Fed. Cir. 2007), citing *In re Grabiak*, 769 F.2d 729, 226 USPQ 870 (Fed. Cir. 1985). The changes to the structure of a compound in *Takeda* were the changing of a methyl substituent to an ethyl substituent and the changing of the position of this substituent from position 6 on a pyridyl ring of the compound to position 5 in said same ring. These changes were not found obvious from the disclosure of the prior art.

Also, note in this regard, particularly, the analysis used by the Court in *Jones*. The group at issue in *Jones* had the structure



The PTO tried to rely on the single reference's compound having two CH₂CH₂OH groups attached to a single N atom, instead of linked together as shown above. The Court stated that one could not ignore the fact that the two CH₂CH₂OH groups were not joined together to form the ether linkage-containing group required in the claim. One could not simply rely on the “-CH₂CH₂O-” features of the reference; one had to consider the entirety of the structure involved. The Patent and Trademark Office also tried to rely on a morpholino group in the single reference wherein the nitrogen atom has two ethyl groups bonded to it and linked to each other by a single oxygen atom, thereby allegedly providing the “missing” ether oxygen noted above. Again, the Court stated that one could not ignore the entirety of the structure, i.e., the fact that this prior art group compound was cyclic. One could not apply components of its structural features in isolation apart from the group's overall structure. Other similar analyses were rejected by the Court.

Disclosure of a particular generic formula or various species thereof with their particular set of structural components, under *Takeda, Jones and Baird*, does not motivate one of ordinary skill in the art to select various structural features from different compounds in isolation and apply them to other compounds.

The lack of obviousness here is further enhanced by the fact that the general formula in the reference is very broad. The only constant part of the general formulae disclosed on page 2 is the pyrazole group. All other groups are substituents that can vary in numerous ways. There is nothing in the record that provides support for one to make the alleged modification to the species chosen by the Office Action necessary to achieve a compound of the present claims over any other possible modification encompassed in the broad generic disclosure of WO '394.

Nevertheless, the amendments to the claims even further remove the claimed invention from that of the disclosure of WO '394.

The claimed compounds have to have a bulky group and/or functional group in the para position that is not present in the compounds according to the reference.

Applicants believe, although do not wish to be bound by this belief, that this bulky and/or functional group attributes to the potent 5HT activity of this class of compounds, which activity is not even disclosed in WO '394.

There is no teaching or suggestion in the cited prior art, including in WO '394, that the claimed compounds are potent 5HT active compounds.

Accordingly, reconsideration is respectfully and courteously requested.

Withdrawn Claims

Applicants continue to respectfully disagree with the restriction.

The Patent Office has not established that it would pose a serious burden on the Examiner to search all the groups. No further, or only a minimal, search would be necessary to allow the remaining groups once the elected claims are allowed.

Regarding the Election of Species Requirement, applicants remind the Examiner in accordance with M.P.E.P. 803.02, that should no prior art be found which renders the invention of the elected species unpatentable, the search of the remainder of the generic claim(s) should be continued in the same application. Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard

as their invention, unless the subject matter in a claim lacks unity of invention. See MPEP 803.02 in accord.

Additionally, applicants bring the attention of the Examiner to MPEP § 821.04, Rejoinder. Accordingly, the rejoinder of the withdrawn method claims is respectfully requested at the proper time in accord with the rejoinder provisions of the MPEP.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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